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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	76293326
Applicant	Prema Jyothi Light
Applied for Mark	SHIMMERING BALLERINAS & DANCERS
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Submission	Applicants Request for Remand and Amendment
Attachments	SHIMMERING BALLERINAS 76293326 REQ4REMAND 01-10-11.pdf ( 3 pages ) (11418 bytes )
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Signature	/ prema jyothi light /
Date	01/10/2011

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

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NAME OF APPLICANT: Prema Jyothi Light

NAME OF TRADEMARKS: SHIMMERING BALLERINAS & DANCERS

SERIAL NUMBERS: 76293326

FILING DATE OF APPLICATIONS: First filed: July 9, 2001  
Later refiled: July 31, 2001

DATE OF MOST RECENT TTAB ORDER: November 9, 2010

DATE OF THIS REQUEST: January 9, 2010

EXAMINING ATTORNEY: Paul F. Gast, Esq., Law Office 106

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**REQUEST FOR REMAND TO EXAMINING ATTORNEY  
FOR FURTHER CONSIDERATION OF REQUEST FOR RECONSIDERATION**

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Applicant Light wishes to hereby thank the Board for extending the due date for this brief, and for granting parallel handling for the two sister Trademarks, SHIMMERING BALLERINAS & DANCERS and SHIMMERING RAINFOREST.

This brief is a REQUEST FOR REMAND to the Examining Attorney for the reasons set forth in the earlier REQUEST FOR RECONSIDERATION. Those reasons include:

1. **TMEP § 715.04(b), Examining Attorney's Action When New Issue or New Evidence is Presented and Notice of Appeal Has Been Filed:**

“If the request for reconsideration includes an amendment that presents a new issue, the examining attorney must issue a new nonfinal Office action with a six-month response clause.”

2. **And further:**

“When the examining attorney issues a new action, the Office action should explain that the applicant must respond to all requirements or refusals within six months of the mailing date of the action and that the appeal will remain suspended while the application is on remand.”

3. Applicant's Request for Reconsideration did present a New Issue, namely, a claim of acquired distinctiveness, in the alternative, under 15 U.S.C. §1052(f). According to TMEP § 1212.02(h), a § 2(f) claim of acquired distinctiveness is considered to be a New Issue.
4. Also, according to TMEP § 1212(c),  
  
"When an applicant claims acquired distinctiveness in the alternative, the examining attorney should treat separately the questions of: (1) the underlying basis of refusal and; (2) assuming the matter is determined to be registrable, whether acquired distinctiveness has been established."
5. However, in his letter dated January 28, 2010, denying Applicant's Request for Reconsideration, the Examining Attorney did not address this New Issue of acquired distinctiveness at all. This New Issue is separate from any other issues discussed in the Final Office Action dated June 15, 2009, and under the above provisions of the TMEP and federal law, requires a separate, nonfinal response.
6. However, this claim of acquired distinctiveness under 15 U.S.C. §1052(f) is made in the alternative, in accordance with TMEP §1212.02( c). Under this section, claiming acquired distinctiveness in the alternative, the alternative claim does not constitute a concession that the matter sought to be registered is not inherently distinctive.

For the above reasons, Applicant Light respectfully requests a Remand of her Trademark application back to the Examining Attorney, for further consideration, proper evaluation, and proper response to her Request for Reconsideration, with a nonfinal office action in response, as required by TMEP § 715.04(b), as her Request for Reconsideration contained New Issues, in conformance with the above-cited provisions of TMEP § 715.04(b), TMEP § 1212.02(h), and 15 U.S.C. §1052(f).

In support of this request, Applicant Light is sending specimens showing how the Trademarks have been used, establishing acquired distinctiveness for the Trademarks.

These are being sent under separate cover, via ESTTA, with a separate ESTTA filing receipt number for each specimen. This is a safeguard against mishandling of her specimens by PTO staff members. Her earlier specimens sent by surface mail, in a sizeable box, simply disappeared within the PTO, and no explanation has ever been given for this.

It is Applicant Light's feeling that it would be best for each specimen to be sent separately via ESTTA, with its own separate filing receipt, to establish receipt by the TTAB of each specimen submitted.

Further, after all specimens have been successfully sent and received, Applicant Light will confirm all of the ESTTA tracking numbers, and receipt of all of the documents, including specimens, by phone with the paralegal handling her Trademarks.

Unless there are any delays or variances or mishandling of these documents by PTO staff, everything should be in the hands of the TTAB judges promptly.

Applicant Light was planning to send quite a few specimens in support of each Trademark, but has received advice from someone more knowledgeable in TTAB proceedings than herself, to keep things simpler by sending fewer specimens. If the Examining Attorney needs anything further upon Remand, he can let her know.

Therefore, just three specimens are being sent in support of each of the two Trademarks, or a total of six specimens. Applicant Light will image-capture each step of the ESTTA process for each of the specimens, to further establish the successful sending and receipt of each specimen, and the number of pages sent.

This brief, due on Sunday, January 9, 2011, is being sent timely via ESTTA on Monday, January 10, 2011, with the accompanying and supporting specimens to follow under separate cover via ESTTA within about a week at the latest, in case of any unexpected computer glitches or difficulties with the ESTTA system.

Respectfully submitted,

*/ Prema Jyothi Light /*

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